

REMARKS

In the Office Action mailed December 14, 2004, claims 9-12 and 14-42 were pending. Claims 20-22 have been withdrawn from consideration, and claims 9-12, 14-19, 23-28, 30-33 and 39-42 stand rejected. Claims 35-38 have been cancelled in this response without prejudice to pursuit in a divisional application. Reconsideration of the present application as amended and including claims 9-12, 14-34 and 39-42 in view of the remarks that follow is respectfully requested.

Claims 23-27, 30-32, 39 and 41 were rejected under 35 USC §102(b) as being anticipated by U.S. Patent No. 4,488,543 to Tornier. "[A]n invention is anticipated if the same device, including all the claim limitations, is shown in a single prior art reference. Every element of the claimed invention must be literally present, arranged as in the claim." Richardson v. Suzuki Motor Co. Ltd., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The claims must not be treated as "mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning." Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Company et al., 730 F.2d 1452, 1459, 221 USPQ 481, 486 (Fed. Cir. 1984). As a result, a reference that coincidentally lists features of a claim without describing the claimed arrangement, relationship, and organization of such features cannot anticipate.

The Office Action asserts that fastener 4 is inherently positionable in hole 6 at a plurality of angles relative to the bottom of the plate. However, it is respectfully submitted that Tornier does not disclose an arrangement of elements that includes positioning fastener 4 in hole 6. Tornier discloses that the three holes 6 are arranged for passage "of screws 3 which are the thickest used in combination with this plate since they are to be implanted in the femoral head or in the femoral condyles. The triangular arrangement of holes 6 facilitates an attachment in triangulation of the extremity of the femur under consideration, thereby providing a better balance of the attachment forces during osteosynthesis." *See* col. 2, lines 17-26. Fastener 4, on the other hand, is shown with a size that would not provide any contact with the plate in hole 6 if it were positioned therein. Positioning fastener 4 in hole 6 would thus run counter to the

disclosed arrangement of elements in Tornier, and there is no disclosure of a part-to-part relationship in Tornier where fastener 4 is positionable in hole 6.

Furthermore, for an element to be inherently disclosed, it must “necessarily be present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill.” In re Robertson, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citing Continental Can Co. v. Monsanto Co., 948 F2d 1264, 1268 (Fed. Cir. 1991)). Indeed, inherency “may not be established by probabilities or possibilities . . . The mere fact that a certain thing may result from a given set of circumstances is not sufficient.” 49 USPQ2d at 1951. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” Ex parte Levy, 17 USPQ2d 1461, 1464 (USPTO Bd. of Pat. App. and Interferences 1990) (emphasis in the original). As discussed above, from the disclosure in Tornier, one skilled in the art would not find it necessarily present that fasteners 4 would be positioned in holes 6. The size of holes 6 are much greater than the size of fasteners 4, thus preventing fasteners 4 in holes 6 from securing the plate to bone. Furthermore, Tornier discloses that the fasteners in holes 6 provide a better balance of attachment forces, and a fastener 4 in hole 6 would create imbalanced attachment forces. Accordingly, the disclosure in Tornier is not sufficient to anticipate claims 23, 30 and 39, and withdrawal of this basis of the rejection of these claims is respectfully requested.

Claims 24-27 depend from claim 23, claims 31-32 depend from claim 30, and claim 41 depends from claim 39. These claims are allowable at least because the claim from which each depends is allowable. Accordingly, withdrawal of this basis of the rejection of these claims is respectfully requested.

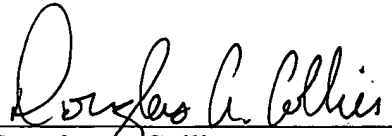
Claims 28, 33, and 42 were rejected under 35 USC 103(a) as being unpatentable over Tornier. Claims 28, 33 and 42 are patentable because the base claim from which each depends is patentable for the reasons provided above.

Claims 9-12, 14-19, 23-28, 30-33 and 39-42 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-55 of U.S. Patent No. 6,669,700 and claims 1-79 of U.S. Patent No. 6,152,927.

Enclosed herewith is a terminal disclaimer, and withdrawal of this basis of the rejection is respectfully requested.

Examination of the present application as amended and including claims 9-12, 14-34 and 39-42 in view of this response is respectfully requested. The Examiner is encouraged to contact the undersigned by telephone to resolve any outstanding matters concerning the present application.

Respectfully submitted:

A handwritten signature in cursive script, reading "Douglas A. Collier", is written over a horizontal line.

Douglas A. Collier
Reg. No. 43,556
Krieg DeVault LLP
One Indiana Square, Suite 2800
Indianapolis, Indiana 46204-2079
Phone: (317) 636-4341
Facsimile: (317) 636-1507